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|---|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 3624 | |

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/827,762 | NABE, OUMAR | |
| | Examiner | Art Unit | |
| | Dan Kesack | 3624 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *06 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-37 and 40-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-37, 40-44* is/are rejected.

7)☒ Claim(s) *40-44* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/30/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This application has been reviewed. Original claims 1-37, 40-44 are currently pending. The rejections are as stated below.

### *Specification*

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 40-44 been renumbered 38-42.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6, 14, 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it is unclear how grouping customers is related to identifying customer needs, as claimed, and furthermore the specification does not provide insight as to how one skilled in the art would practice this method.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1, 3, 5-6, 8, 9, 11, 16, 17, 23, 25-27, 30, 34, 36, 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9, 17, 34 recite, "calculating a probability for each customer". There is no antecedent basis for "customer," and therefore it is unclear which "customer" is being referred to, rendering the claim indefinite.

Claims 1 and 9 recite, "grouping customers into distinct lists based upon at least one of the selected profiles." According to the claimed method, a user is only prompted to select a customer profile. As such, there is no antecedent basis for "selected profiles" and therefore the claim is indefinite.

Claims 1, 3, 5-6, 9, 11, 23, 25-27, 30, 34, 36, and 41 recite "grouping customers" or "bidding on customers". Examiner respectfully notes that it is not possible to group customers or bid on customers, and therefore the claim is indefinite. As described in the specification, the claimed invention groups customer information records, and provides for bidding on customer information records. Examiner respectfully advises Applicant to change the wording to reflect the specification.

Claims 8 and 16 recite calculating "probabilities for customers." It is unclear what the probability relates to, and the claims are therefore rendered indefinite.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 17-21 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

Claim 17 describes a computer which prompts a user to select a customer profile, and performs a calculation and a grouping. The computer does not provide any

real world usable output, and therefore has no asserted or well established utility, as claimed.

Claims 18-21 depend from claim 17, and describe processes executable by the claimed computer, however none of the claims are directed towards a specific and substantial utility.

Claims 17-21 also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

9. Claims 21-26, 40-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21-26 and 40-42 describe a database comprising data. As claimed, the database does not constitute a useful process, machine, manufacture or composition of matter, and is therefore non-statutory.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1, 4, 6, 7, 9, 12, 27, 28, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., U.S. Patent No. 5,835,896 in view of Galperin et al., U.S. Patent No. 6,993,493, Boe et al., U.S. Patent No. 6,236,975, and further in view of Farmer's "Toysmart suspends auction of customer list."

Claims 1, 4, 6, 7, 9, 12, 27, 28, 34, Fisher discloses a system and method for conducting a multi-person, interactive auction, comprising prompting a user to search for a desired good or service (column 6 lines 33-34), displaying goods and services that match desired parameters, including detailed information describing the good or service available for bidding (column 7 lines 10-15), and prompting a user to bid on the good or service based on the description (column 6 lines 31-38).

Claims 1, 4, 9, 12, 27, 28, 34, Fisher fails to teach calculating a probability for each customer.

Galperin teaches a method for forecasting the profitability of a marketing campaign by calculating probabilities that individual customers will respond to a given promotion (column 3 lines 25-28). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the steps of calculating probabilities for customers in the auction method of Fisher, because the auctioning of customer lists was known in the art at the time of the Applicant's invention, and required a detailed description of the list for sale. Farmer's article, "Toysmart suspends auction of customer list" describes the auctioning of customer information. By describing a customer list by the probability of response of the customers contained therein, the auction method of Fisher has an objective quantifiable description of the good for sale, upon which a buyer can base a submitted bid.

Claims 1, 7, 9, 34, Fisher fails to teach accessing a database of customers and grouping customers into distinct lists based on calculated probabilities.

Boe teaches a method for profiling customers including accessing a customer database (figure 2, #58), and grouping customers with common characteristics and who share the same probability of purchase, and directing specific marketing towards that group (column 19 lines 30-35). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the steps of grouping customers by probability to respond in the auction method of Fisher, because the auctioning of

customer lists was known in the art at the time of the Applicant's invention. Farmer's article, "Toysmart suspends auction of customer list" describes the auctioning of customer information. The items for auction in the catalogs of Fisher are classified by item description, and therefore the customer groupings of Boe can be used as a classification parameter.

13. Claims 8, 16, 17, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher, Galperin, Boe, and Farmer as applied to claim 1 and 9 above, and further in view of Reed, "Spatial Modeling And Data Mining In Retail".

Claims 8, 16, 17, 21, Fisher fails to teach using a propensity model to calculate the probability of response for each customer.

Reed teaches methods for using customer data to predict future customer behavior using a propensity model (page 2, Customer Behavior Variables). It would be obvious to one of ordinary skill in the art to modify the response probability calculation of Galperin to include the use of a propensity model, as was well known at the time of the invention, because the propensity model is a specific tool used to provide predictions of future customer behavior, and Galperin teaches using customer data to predict future customer behavior.

14. Claims 2, 3, 10, 11, 29, 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher, Boe, Farmer, Galperin, and Reed as applied to claims 1, 9, and 27 above.

Claims 2, 3, 10, 11, 29, 30, Fisher, Boe, Farmer, and Galperin fail to teach biding on a customer-by-customer basis, and bidding on clustered groups of customers. Official notice is taken that it is old and well known in the art of auctioning that items, such as customer information, may be offering individually, or in lots of multiple items. Therefore it would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to allow for auctions containing a single customer, or containing groups or clusters of customers because single customer bids allow for more specific selection criteria, and a lot of multiple customers may offer the price advantage of bulk purchasing.

15. Claims 5, 13-15, 18 and 19 are rejected under U.S.C. 103(a) as being unpatentable over Fisher, Boe, Farmer, Galperin, and Reed as applied to claims 1, 9, and 17 above, and further in view of Bisgaard-B hr et al., U.S. Patent No. 6,947,878.

Claims 5, 13-15, 18, 19, Fisher, Boe, Farmer, Galperin, and Reed fail to teach using clustering analysis to group customers.

Bisgaard-B hr teaches a system and method for mining data in a customer database, using clustering analysis to group customers based on similarities in data. It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to use the clustering analysis of Bisgaard-B hr to group customers because the clustering provides more descriptive and specific information upon which a buyer can place a bid in an auction.

16. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher, Galperin, Boe, Farmer, and Reed as applied to claim 17 above, and further in view of Boe, as applied to claim 7 above for the reasons listed thereabout.

17. Claims 22, 23, 40-42, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher in view of Boe and Farmer.

Claims 22, 23, 40-42, Fisher discloses a method for auctioning goods and services, including a bid database for holding submitted bids (Figure 4, #31), and grouping the goods and services for sale by the description (column 7 lines 10-15).

Fisher fails to teach grouping customers by behavioral characteristics.

Boe teaches a method for profiling customers including accessing a customer database (figure 2, #58), and grouping customers with common characteristics and who share the same probability of purchase, and directing specific marketing towards that group (column 19 lines 30-35). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the steps of grouping customers by probability to respond in the auction method of Fisher, because the auctioning of customer lists was known in the art at the time of the Applicant's invention. Farmer's article, "Toysmart suspends auction of customer list" describes the auctioning of customer information. The items for auction in the catalogs of Fisher are classified by item description, and therefore the customer groupings of Boe can be used as a classification parameter.

18. Claims 24-26, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher in view of Boe and Farmer as applied to claim 22 above, and further in view of Galperin.

Claims 24-26, 31-33, Fisher, Boe and Farmer fail to teach calculating a probability of response for each customer.

Galperin teaches a method for forecasting the profitability of a marketing campaign by calculating probabilities that individual customers will respond to a given promotion (column 3 lines 25-28). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the steps of calculating probabilities for customers in the auction method of Fisher, because the auctioning of customer lists was known in the art at the time of the Applicant's invention, and required a detailed description of the list for sale. Farmer's article, "Toysmart suspends auction of customer list" describes the auctioning of customer information. By describing a customer list by the probability of response of the customers contained therein, the auction method of Fisher has an objective quantifiable description of the good for sale, upon which a buyer can base a submitted bid. The resulting description is stored in the merchandise description database of Fisher (figure 4, #30).

19. Claims 35-39 are rejected under U.S.C. 103(a) as being unpatentable over Fisher, Boe, Farmer, and Galperin as applied to claim 34 above.

Claims 35 and 36, Fisher, Boe, Farmer, and Galperin fail to teach biding on a customer-by-customer basis, and bidding on clustered groups of customers.

Official notice is taken that it is old and well known in the art of auctioning that items, such as customer information, may be offering individually, or in lots of multiple items. Therefore it would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to allow for auctions containing a single customer, or containing groups or clusters of customers because single customer bids allow for more specific selection criteria, and a lot of multiple customers may offer the price advantage of bulk purchasing.

Claim 37, Galperin teaches a method for forecasting the profitability of a marketing campaign by calculating probabilities that individual customers will respond to a given promotion (column 3 lines 25-28). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the steps of calculating probabilities for customers in the auction method of Fisher, because the auctioning of customer lists was known in the art at the time of the Applicant's invention, and required a detailed description of the list for sale. Farmer's article, "Toysmart suspends auction of customer list" describes the auctioning of customer information. By describing a customer list by the probability of response of the customers contained therein, the auction method of Fisher has an objective quantifiable description of the good for sale, upon which a buyer can base a submitted bid. The resulting description is stored in the merchandise description database of Fisher (figure 4, #30).

Claim 38, Boe teaches a method for profiling customers including accessing a customer database (figure 2, #58), and grouping customers with common characteristics and who share the same probability of purchase, and directing specific marketing towards that group (column 19 lines 30-35). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the steps of grouping customers by probability to respond in the auction method of Fisher, because the auctioning of customer lists was known in the art at the time of the Applicant's invention. Farmer's article, "Toysmart suspends auction of customer list" describes the auctioning of customer information. The items for auction in the catalogs of Fisher are classified by item description, and therefore the customer groupings of Boe can be used as a classification parameter.

Claim 39, Reed teaches methods for using customer data to predict future customer behavior using a propensity model (page 2, Customer Behavior Variables). It would be obvious to one of ordinary skill in the art to modify the response probability calculation of Galperin to include the use of a propensity model, as was well known at the time of the invention, because the propensity model is a specific tool used to provide predictions of future customer behavior, and Galperin teaches using customer data to predict future customer behavior.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HANI M. KAZIMI
PRIMARY EXAMINER